

**This Opinion is Not
Citable as Precedent
of the TTAB**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Pfizer Inc.
v.
Soft Gel Technologies, Inc.

Opposition No. 117,607
to application Serial No. 75/628,818
filed on January 27, 1999

Nels T. Lippert and Dyan Finguerra-DuCharme of Hale and
Dorr LLP for Pfizer Inc.

Kamran Fattahi of Kelly Bauersfeld Lowry & Kelley, LLP
for Soft Gel Technologies, Inc.

Before Simms, Bucher and Rogers, Administrative Trademark
Judges.

Opinion by Rogers, Administrative Trademark Judge:

Applicant Soft Gel Technologies, Inc. has applied to register GLUCOSOL as a mark for "dietary and nutritional supplements." The involved application was filed January 27, 1999 on the basis of applicant's stated intention to use the mark in commerce. Although the record is clear that applicant shortly thereafter began using the mark,

the application was published for opposition without prior amendment to assert use of the mark in commerce.

Pfizer Inc., under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), has opposed the application.

Opposer pleaded that it has prior and continuing use of the marks GLUCOTROL (since May 1978) and GLUCOTROL XL (since December 1993) for antidiabetic preparations.

Further, opposer pleaded that each of these two marks has been registered for such goods and that the registrations are "valid and subsisting." Opposer's marks are asserted to be inherently distinctive and strong and the parties' respective marks are asserted to be "substantially similar in sound, appearance, connotation and commercial impression." Opposer also asserts that the respective goods are substantially similar in their intended purpose, channels of trade and classes of purchasers.

Finally, opposer has alleged that there will be a likelihood of confusion among consumers, or they will be mistaken or deceived, by concurrent use of its and applicant's marks in the marketplace and has made various allegations regarding the damage it will suffer if applicant's mark is registered.

Applicant, in its answer, admitted only opposer's allegations relating to the filing of applicant's

application and that, if applicant's mark were to be registered, applicant would thereby obtain certain rights. Also, applicant essentially admitted that, if opposer were to prove ownership and validity of the pleaded registrations there would be no issue as to priority. Applicant has denied, expressly or effectively, all other allegations of the notice of opposition.¹

Prior to trial, the parties filed two stipulations. One provided that the parties would accept as authentic documents produced pursuant to requests under Rule 34 of the Federal Rules of Civil Procedure and that such documents could be introduced "by either party," subject to objections "on the grounds of competency, relevancy and materiality." The other provided for the protection of the parties' confidential documents and information. A Board attorney previously approved the latter stipulation and the former stipulation now is also approved.

At trial, each party offered testimony and exhibits, and each party filed a notice of reliance. By the latter

¹ Though applicant pleads that there will be no likelihood of confusion, mistake or deception as an "affirmative defense," this is not a true defense and is viewed merely as an amplification of applicant's denial of opposer's allegations to the contrary.

filings, each party introduced the interrogatory responses of the other, opposer introduced certified copies of its pleaded registrations (establishing that the registrations are valid and owned by opposer), opposer introduced documents and things produced by applicant, and applicant introduced copies of non-party trademark registrations. Each party filed a brief, but opposer did not file a reply brief; and each party was represented at an oral hearing. Opposer, in its brief, objects to consideration of some of the evidence introduced by applicant, as well as some of the testimony of its own witnesses elicited during cross-examination.

Objections to Evidence

Opposer objects to applicant's introduction of copies of third-party registrations as well as exhibits (and testimony related thereto) offered to show use of certain third-party marks. Opposer also objects to testimony related to applicant's exhibits 29 and 30, exhibits which have not been made of record because applicant has acknowledged and acceded to opposer's objections. Finally, opposer objects to consideration of the testimony of its own witnesses, elicited by applicant during cross-examination of each of these witnesses, regarding (1) selection, creation and connotation of

opposer's marks, (2) opposer's sale and promotion of its involved products, (3) testimony regarding instances of actual confusion (or lack thereof), and (4) testimony regarding what may be considered "competing products" under the likelihood of confusion analysis required by this case.

We overrule the objections regarding third-party registrations and what is asserted by applicant to be evidence of third-party uses of certain marks. Opposer's objections to these items are rooted in its perception of applicant's reason for offering the evidence and opposer's conclusion that the evidence is not probative when considered for the perceived reasons for offering it. We have considered this evidence for the probative value it has, which is not much, but do not find it appropriate to exclude this type of evidence, which is routinely offered in Board proceedings. *See, e.g., The Sports Authority Michigan, Inc. v. The PC Authority, Inc.*, 63 USPQ2d 1782 (TTAB 2002).

Opposer's objections to testimony relating to applicant's exhibits 29 and 30 are moot. Since the exhibits discussed during the testimony have not been made of record, the testimony is not relevant to anything in the record and has been given no weight.

Finally, opposer's objections to various items on which its witnesses testified during cross-examination are overruled. Insofar as these objections are based on the witnesses' responses to initial questions that show their knowledge of the subjects listed above is limited or non-existent, the Board has not accorded the testimony great weight, but we have found all the testimony helpful to our overall understanding of the parties, their marks and their operations. Thus, we have not excluded any testimony based on technical objections.²

The Parties and Their Arguments

We briefly summarize the nature of the parties' businesses and the use of their marks, as well as their arguments, solely to provide background for the decision that follows. There is more detailed discussion interspersed in the various sections of our analysis of the likelihood of confusion factors.

Opposer is a large pharmaceutical house, with numerous products intended to aid in the treatment of

² As a general observation, we note that opposer's counsel raised objections during depositions with great, perhaps unnecessary, frequency. On the other hand, applicant's counsel clearly asked a great many questions that were lightning rods for objections. We have looked past this sparring of counsel and to the essence of the testimony, but have given weight only to the testimony and exhibits with proper foundation, relevance and materiality.

various diseases. It has been involved in research and the creation of treatments for diabetes for more than 40 years. It markets two oral medications for the treatment of diabetes in Type II patients, as opposed to Type I or juvenile diabetes patients, namely GLUCOTROL and GLUCOTROL XL.

Applicant began business in 1995 and manufactures soft gelatin capsules and products contained therein. It manufactures dietary or nutritional supplements and herbal or natural alternatives to medications. Some of these products are applicant's own formulations, while others are custom formulations made to the order and specification of others. One of applicant's products, manufactured primarily for private label sales, is the dietary supplement known as GLUCOSOL. In many instances, applicant's GLUCOSOL product is just one ingredient in a custom supplement manufactured for a particular customer. The record is clear that GLUCOSOL is touted both as a means for balancing blood sugar and as a weight loss product.

Opposer argues that there is no issue as to priority; that, in this proceeding focusing solely on applicant's right to the registration it seeks, we must

focus on the involved identifications, which are broad; that, as a result, the identifications overlap; that the marks are very similar; and that, analyzed under the appropriate likelihood of confusion factors, there is a great likelihood of confusion.

Applicant, in contrast, argues that the parties' respective products are very different, do not share common channels of trade, and are marketed to sophisticated consumers. Applicant also considers the marks to be very different, especially in connotation and pronunciation. Moreover, applicant views opposer's marks as weak, because they are highly suggestive, and entitled to a narrow scope of protection, particularly in view of the many GLUCO- formative marks it says populate the drug and supplement fields.

We have considered the entire record, and discuss, in this decision, items of particular significance. Likewise, we have considered all the arguments of the parties, and to the extent a party perceives the absence of discussion of a particular argument as indicating we did not consider such argument, we assure the parties that is not so. See General Foods Corp. v. Studiengesellschaft Kohle mbH, 972 F.2d 1272, 23 USPQ2d 1839, 1847 (Fed. Cir. 1992).

Decision

There is No Issue as to Priority

Opposer has introduced into the record certified copies of its two pleaded registrations, which show that they are valid and owned by opposer. Thus, as applicant correctly admitted in its answer, this proof removes the issue of priority from this case. King Candy Company v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Likelihood of Confusion Factors

The Court of Customs and Patent Appeals, the predecessor court of the Court of Appeals for the Federal Circuit, set out a non-exclusive list of thirteen factors to be considered when determining whether one mark is likely to cause confusion with another mark. In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). Our discussion focuses on those *du Pont* factors the parties have highlighted in their briefs and consider the most relevant, as well as any factor for which probative facts are established by the record.

Similarity of the marks

Applicant argues that we should focus on the GLUCOTROL XL mark because 98 to 99 percent of

antidiabetic preparations sold by opposer under its two pleaded marks are sold under GLUCOTROL XL rather than GLUCOTROL and that opposer has admitted that it no longer is actively marketing or promoting the product branded GLUCOTROL. Brief p. 2. The GLUCOTROL mark, however, is still registered and is not the subject of a counterclaim. For this proceeding, in which we must focus on whether applicant's mark should be refused registration based on either or both of opposer's existing registrations, we cannot diminish the presence of GLUCOTROL on the register.

Even if we were able to focus -- as a district court could -- more closely on the marketplace than on the register, we would not limit our comparison, as applicant would have it, to GLUCOTROL XL and GLUCOSOL. This is because the record reveals that applicant's mark has also been presented as GLUCOSOL 24 and GLUCOSOL 48. The record also reveals that 24 and 48, when used with applicant's mark, and XL, when used with opposer's GLUCOTROL mark, are intended to be descriptive suffixes regarding properties of the respective products.³ Thus,

³ Testimony of Kathryn Ferren p. 46 and applicant's exh. 21, illustrating use of GLUCOSOL 24 and GLUCOSOL 48, respectively, for 24 and 48 mg softgel capsules. Testimony of Kevin Reineke p. 126, who, on cross-examination, stated that XL means extended release. See also, opposer's response to applicant's

suffixes like these would not be viewed by prospective purchasers or end users as designations of the source of the products. Rather, they would instead focus on GLUCOTROL and GLUCOSOL.

Applicant contends the marks will be pronounced differently⁴, but it is well established that a mark owner cannot control how its mark will be pronounced when spoken. Yamaha International Corp. v. Stevenson, 196 USPQ 701, 703 (TTAB 1977). See also, duPont v. Sunlyra Int'l Co., 35 USPQ2d 1787, 1789 (TTAB 1995). When considered in their entirety, we find the marks very similar in sight and sound. See Pennwalt Corporation v. Center Laboratories, Inc., 524 F.2d 235, 187 USPQ 599, 601 (CCPA 1975) (marks ALLEREST and ALLERSET "very similar when considered in their entirety, in appearance, sound and commercial impression"); Pharmacia & Upjohn Co. v. Generation Health, 44 USPQ2d 1091, 1094 (W.D.Mich. 1997) (it "cannot seriously be questioned that

interrogatory no. 17: "The 'XL' is used to differentiate the immediate release from the controlled release." Applicant has accepted this testimony and response as accurate. App. brief, pp. 6 and 8.

⁴ A significant reason why applicant believes the marks will be pronounced differently is based on its contention that the SOL portion of its mark will carry a certain connotation. We discuss this infra and conclude that the record is equivocal at best. Thus, applicant's support for its contention that the marks will be pronounced differently also is lacking.

the marks [COLESTID and CHOLESTIN] are similar in appearance and spelling" and their "phonetic similarity exceeds their visual similarity").

In regard to the connotations of the marks, applicant contends GLUCOTROL would be perceived as a combination of "Glucose" and "Control" and that GLUCOSOL would be perceived as a combination of "Glucose" and "Solubilized." Applicant asserts the "SOL" portion of its mark would be "known very well" because of applicant's mark COQSOL for an oil soluble Co-enzyme Q-10, which is asserted to be "the largest in that one, in the Co Q-10 field." Testimony of Ronald Udell pp. 17-18. We have no evidence, however, regarding the COQSOL product and how well known are the "Co Q-10" product and the mark used therefor. Therefore, there is nothing in the record from which to impute that applicant's mark will, in fact, be perceived as a combination of "Glucose" and "Soluble" or "Solubilized." It may be just as likely that prospective purchasers or users will consider the SOL portion to be a reference to corosolic acid, i.e., the active ingredient identified on packaging for applicant's capsules. (Opposer's exh. 26, an actual package of applicant's GLUCOSOL capsules, as marketed by a third party, makes no reference to the product being

oil soluble, but does refer to corosolic acid as the active ingredient.) In any event, even if we agree that GLUCOSOL would not have the same connotation as GLUCOTROL, that does not overcome the visual and phonetic similarity of the marks, which we find more significant than any possible differences in connotation. See Clairol Incorporated v. Roux Laboratories, 442 F.2d 980, 169 USPQ 589, 590 (CCPA 1971) (Even though the words "Plus" and "Puff" "may have different meanings by themselves, this difference alone does not overcome the conclusion that when the marks are viewed in their entireties a likelihood of confusion exists."). See also, Miles Laboratories, Inc. v. Whorton Pharmacal Company, 199 USPQ 758, 761 (TTAB 1978) (Marks ACNETONE and ACNE-DOME "scarcely distinguishable, especially in sound" and "any difference in connotation will not have any practical chance of avoiding error.").

In sum, we find the marks substantially similar.

Relatedness of the Goods

Applicant, in arguing that the involved goods are unrelated, stresses that it markets a dietary supplement that is a "natural" or herb-based alternative to medication and opposer markets a pharmaceutical available by prescription only. Opposer, on the other hand, views

applicant as a competitor. Testimony of Susan Domotor pp. 25 and 55-56; Reineke test. p. 120. It is clear the respective products actually marketed by the parties are not competitive but, nonetheless, are related, in that they are both touted as a means for balancing blood sugar levels.⁵ See *Pharmacia*, supra, 44 USPQ2d at 97.

Applicant's witnesses testified, and applicant argues in its brief, that its product is, in fact, primarily a weight loss aid and is promoted as such. The record is not very supportive. Applicant's marketing director asserted that GLUCOSOL initially was marketed to its customers as a means for balancing blood sugar levels, but that the focus changed to weight loss. Ferren test. p. 17. Yet this witness also identified numerous exhibits in the nature of marketing material, reported still to be in use, which tout the benefits of applicant's product for balancing blood sugar in both healthy individuals and in individuals with Type II diabetes. See, e.g., applicant's exhibit 4 ("Soft Gel Technologies, Inc. is pleased to offer Glucosol™ to

⁵ We also note applicant's exhibit 36 to the Ferren testimony deposition. This is a copy of a magazine entitled "Outsmart Diabetes" (bearing the legends "From the Editors of Prevention" and "Display until June 29, 2001"). Within this publication are articles on both medication and herbal supplements: "DIABETES RX Everything You Need to Know about Diabetes Medications" and "HERB NEWS Mother Nature's Diabetes Defense."

marketers looking for unique products to incorporate into their diabetes or weight loss formulations.") and exhibit 12 ("Depending on your preference, Glucosol works as a solo formula or can be combined with your custom Diabetic turn key formulations. Research has shown maintaining ideal blood glucose levels is a winning strategy for Type II Diabetics, adding weight loss to the package only sweetens the deal.").

Equally important, we note that opposer is correct in its observation that we must, in this proceeding, focus on products encompassed by the identifications set forth in the involved application and registrations, not merely the products actually marketed by the parties.

Octocom Systems Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990), and Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

In this respect, our concern must be with the potential for confusion based on concurrent use of the involved marks for products encompassed within the identifications, even if some of these may not now be in use. See *Pennwalt*, supra, 187 USPQ at 601, wherein the Court was equally concerned with appellant's over-the-

counter drugs and the fact that prescription drugs would be encompassed by the identification in its registration. *See also, Miles Laboratories, supra*, 199 USPQ at 760, and *Meyer Laboratories, Inc. v. Diurcap Corporation*, 163 USPQ 595, 596-97 (TTAB 1969). Thus, we agree with opposer's contention that we must read its identified goods, i.e., antidiabetic preparations, to include both prescription and over-the-counter medicines. In fact, we also consider antidiabetic preparations to be broad enough to encompass homeopathic or "natural" preparations, rather than drug-based preparations. Likewise, while we do not necessarily agree with opposer's contention that applicant's identification should be read to include prescription supplements⁶, we do agree with opposer's contention that we should read the identification to include all sorts of dietary and nutritional supplements, including those which may be specifically formulated for diabetics.

In sum, the goods as actually marketed by the parties are related and opposer's identification is broad and can be read to include prescription medicines, over-

⁶ Dietary supplement appears to be a term specifically used to identify non-drug preparations, so that the producer is not subject to federal Food and Drug Administration regulations. *See, e.g., Eli Lilly & Co. v. Natural Answers Inc.*, 233 F.3d 456, 56 USPQ2d 1942, 1946 (7th Cir. 2000).

the-counter medicines, and even natural preparations intended to combat diabetes, while applicant's identification can be read to include dietary and nutritional supplements for diabetics.

Established Channels of Trade/Possible Expansion

Neither opposer nor applicant sells its product directly to consumers (i.e., end users of their products), and do not appear to sell to the same types of retailers. Opposer sells its antidiabetic preparations to wholesalers that then sell to retail pharmacies, and to certain large retailers who maintain their own warehouses and distribution networks. Reineke test. pp. 7-8; Testimony of Katherine Paul pp. 7, 12-13. Applicant sells supplements of its own formulation or mixed formulations made to the specification of others. Some of its own formulations may be sold directly to wholesalers or retailers, but almost all of its sales, including all of its custom formulations, are to other entities that resell the products under their own labels. Udell test. pp. 8-10. Trader Joe's was identified as the only non-private label end retailer to whom applicant sells a GLUCOSOL product; the vast majority of applicant's products, whether "straight" GLUCOSOL or a custom formulation, are sold on a private label basis to

companies that distribute or resell to others. Udell test. pp. 26-29. Applicant's products are sold by multi-level marketers (50 percent of applicant's sales), health food stores (35-40 percent), and mail order catalog companies. Ferren test. p. 21. In fact, applicant's product could, in theory, appear wherever supplements are sold, since it does not control distribution by those to whom it sells its products. Udell test. p. 32. Such ultimate sales locations could include health food or supplement sections of pharmacies. Udell test. p. 37.

On this record, we find that the parties' respective products are generally sold only to sophisticated wholesalers, retailers or resellers who would be expected to know the difference between a drug product and a dietary supplement. We cannot tell from the record whether the parties may sell to some of the same wholesalers or resellers that distribute various products to retail pharmacies, but we consider this a possibility not foreclosed by the record. Nor are there restrictions in the respective identifications as to channels of trade, and therefore we must consider the goods to move in all customary channels of trade, including to large resellers who market all sorts of products to retail pharmacies. *Octocom Systems*, supra, 16 USPQ2d at 1787.

("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed").

Based on established channels of trade, the parties appear to market their products, for the most part, to separate types of wholesalers or resellers. On the other hand, there are no such restrictions in the identifications and, therefore, we must consider that the parties could utilize the same channels of trade and that their products can appear in the same retail pharmacies and other stores that retail both drugs or medicines and dietary supplements or natural remedies.

Customers of the Parties and Purchasing Conditions

Under this factor, we are concerned both with direct purchasers, i.e., the wholesalers and resellers discussed above, and with end purchasers, i.e., diabetics who are given prescriptions for opposer's product, diabetics who would be candidates for purchasing over-the-counter diabetes medicine or supplements, and purchasers of dietary supplements, including supplements touted to help

control blood sugar (which can include both diabetics and non-diabetics). As noted above, we consider the wholesalers and resellers who are the direct purchasers of these products to be sophisticated and careful in their purchasing. The degree of care exercised by end users may, however, vary with circumstances.

Existing customers of applicant certainly will not purchase opposer's prescription medication without the advice of a physician or other health care provider with prescribing authority. Similarly, existing customers for opposer's prescription medication are more likely than not to consult with their physicians before adding a blood sugar-controlling dietary supplement to their regimen. On the other hand, purchasers of dietary supplements for controlling blood sugar may, if afforded the opportunity to obtain an over-the-counter blood sugar-controlling medication -- which, as we have noted, is encompassed by opposer's identification -- may very well do so without the advice of a physician. Without the opportunity to be educated by a physician as to the source and composition of the respective products, this last group of end users may not be particularly careful in their purchases and may assume some common source or sponsorship of the GLUCOSOL dietary supplement and

GLUCOTROL or GLUCOTROL XL over-the-counter products. See, e.g., *Eli Lilly*, supra 56 USPQ2d at 1946 (7th Cir. 2000), wherein the court found the potential for confusion of PROZAC for a prescription drug and HERBROZAC for a supplement based on evidence that pharmaceutical companies were expanding product lines to include dietary supplements based on "St. John's Wort."

In terms of the various classes of direct consumers and end purchasers there are more types of customers apt to make their purchasing decisions with care than vice versa. Nonetheless, the sophisticated decision-making of most direct purchasers and even many ultimate purchasers may be outweighed by the need to avoid a likelihood of confusion when products are used in the same field. *Pennwalt*, supra, 187 USPQ at 601. Moreover, we note that the analysis of likelihood of confusion is to be more vigorously applied when pharmaceuticals are among the involved goods. See *Miles Laboratories*, supra, 199 USPQ at 761.

Fame of Opposer's Marks

Citing Kenner Parker Toys Inc. v. Rose Art Industries, Inc., 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992), opposer argues that a mark is famous if it is distinctive, supported by significant expenditures on

advertising and is used for a product of "lasting value." Further, opposer argues its marks meet these "requirements" and that "the Board may regard the GLUCOTROL marks as strong." Brief p. 22.

Opposer asserts that its marks are "incontestably distinctive," in an apparent reference to the age of its registrations and that it has filed affidavits of incontestability for each of them.⁷ While we agree with applicant that opposer's mark is readily perceived as suggesting the term "glucose control," opposer is correct that a suggestive mark is technically distinctive, as opposed to a descriptive or generic term. However, even though a mark may be technically distinctive and even incontestable, it may still be considered a commercially weak mark. See, e.g., *Pharmacia & Upjohn*, supra, 44 USPQ2d at 1096. (Plaintiff's COLESTID mark for a cholesterol lowering pharmaceutical held "commercially weak" because it commanded only "0.63 percent of the market" for such drugs and, despite 20 years of extensive promotion to physicians and pharmacists, had never been advertised on radio, television or in any consumer publications).

⁷ See Section 15 of the Lanham Act, 15 U.S.C. § 1065.

Thus, we turn to an assessment of the strength of opposer's marks in the marketplace. The record is clear that opposer has engaged in extensive marketing of its GLUCOTROL and GLUCOTROL XL products. Both parties have submitted sales and marketing information under seal, so we cannot recite actual expenditures. We can say, however, that in the three years in which both parties' products have been in the marketplace, opposer has spent more than 310 times what applicant has spent on marketing. Also, while opposer's marketing expenses in 1999 and 2000 -- the last two years for which we have been provided full-year figures -- were significantly greater than in each of the five previous years, opposer has consistently spent a great deal of money advertising and marketing its products. Annual product sales figures are many multiples of its annual marketing figures. In addition, opposer's products command a 15 percent share of the market for oral diabetes medications, placing it second in that field. Domotor test. pp. 22, 49-50. Under one estimate, 800,000 of the 6 million diabetics actively receiving some sort of treatment for their disease would be taking opposer's GLUCOTROL or GLUCOTROL XL products. Reineke test. pp. 67-68.⁸

⁸ We note that 15 percent of 6 million patients is actually

Also contributing to the strength and renown of opposer's marks are the wide variety of types of advertising and promotion opposer utilizes. The vast majority of advertising and marketing -- 98 percent -- is directed to health care providers and patients, rather than the large wholesalers that are the primary direct purchasers of opposer's products. Reineke test. pp. 8, 108. Thus, almost all of opposer's considerable marketing efforts are directed toward creating brand awareness among those who can recommend opposer's medicine to patients and to patients who can ask their health care providers about the product. Opposer's testimony varied as to whether the ratio of marketing expenses, as between health care professionals and patients was 80/20 or 60/40. Reineke test. pp. 9-10, 108-116. It is clear, however, that at least one-fifth, and possibly as much as two-fifths of the vast majority of opposer's advertising and marketing effort is directed to patients. Even much of the marketing material created

900,000, not 800,000. However, we note that opposer has also testified that 5 percent of diabetics are not Type II diabetics for whom oral medication would be a treatment option, i.e., they are insulin-dependent diabetics. Domotor test. p. 12. If we reduce 6 million patients by 5 percent and then calculate what opposer's 15 percent market share would be, it still exceeds 800,000. Accordingly, we accept opposer's estimate of the number of patients receiving its medication as at least 800,000 and possibly more.

for initial distribution to health care providers may often be passed on to patients or prospective patients, for sharing and discussion with friends and family; and opposer's website has information targeted specifically to those researching diabetes and information about the potential benefits of opposer's diabetes medication.

See, generally, Domotor and Reineke test. We find the record sufficient to establish recognition of opposer's medication and marks not just among vast numbers of internal medicine and family practice physicians, but also among its patients, prospective patients and families of patients or prospective patients.

While the record of opposer's marketing efforts and sales results are very impressive, we cannot say, on the record before us, that opposer's product is like the product of the opposer in *Kenner Parker*, insofar as the opposer in that case was said to have had a "piece of gold" that, at one time, had been the most advertised product in its industry. Thus, while we do not find opposer's marks unquestionably famous, we do find them to be commercially very strong.

Number and Nature of Similar Marks for Similar Goods

As previously discussed in regard to opposer's various evidentiary objections, opposer has strongly

objected to our consideration of applicant's evidence of the registration of GLUCO- formative marks and applicant's testimony and exhibits about finding such marks used on the Internet or in available brochures or publications. While we have overruled opposer's objections and considered such evidence, we do not find the evidence particularly probative of the result applicant seeks, i.e., a finding of no likelihood of confusion.

As to the registrations of other marks, these are, as is well settled, insufficient to show that those marks are in use or that the public is familiar with them. Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). They, can, on the other hand, be referenced in the manner that dictionary definitions are, i.e., to show the meaning or significance of a portion of a mark. See The Conde Nast Publications Inc. v. Miss Quality, Inc., 180 USPQ 149, 152 n.3 (TTAB 1973), aff'd , 507 F.2d 1404, 184 USPQ 422 (CCPA 1975). Further, such registrations may be probative evidence of the suggestiveness of a common portion of a multitude of marks, that such portion is adopted because of its suggestiveness, and that it is the other elements or portions of the various marks that

serve to differentiate them. *Sports Authority Michigan, Inc.*, 63 USPQ2d at 1798.

When we consider the registrations applicant has referenced under this analysis, we find the approximately two dozen GLUCO-formative marks⁹ registered for products specifically identified as related to diabetes, or registered for dietary supplements, as probative evidence that the GLUCO- portion of these marks is intended to suggest the term "Glucose." Opposer has argued that it finds each of these marks distinguishable from its own and from applicant's mark because not one ends in "OL." This is entirely consistent with the observation in *Sports Authority* that marks employing a common element or portion may be considered distinguishable because of their other elements or portions.

Applicant also contends, however, that opposer cannot explain why "noninvasive GLUCONTROL" (in stylized form, with "noninvasive" in smaller, lower-case lettering and the subject of a disclaimer), registered for a medical device used to measure an individual's blood

⁹ Among the registrations there is also the mark GLYTROL, which is, of course, not probative of the significance of frequent adoption of GLUCO- as the initial portion of a variety of marks. Nor can it be considered very probative of the significance of the TROL suffix, as it is the only registered mark among those noted by applicant that includes that suffix.

sugar level, can coexist with opposer's marks. Opposer's response is that it does not consider this to be a GLUCO-formative mark, because of the presence of the term "noninvasive," and because the stylization of GLUCONTROL includes a larger "C" so that the term is, therefore, more properly perceived as a combination of GLU and CONTROL, not GLUCO and NTROL. Moreover, opposer argues that while it is concerned with marks that combine the GLUCO- prefix and end in OL, its commercial concern is with competing marks in International Class 5, which includes pharmaceuticals and dietary supplements, rather than International Class 10, which includes medical devices such as the "noninvasive GLUCONTROL" device. Whether opposer should or should not be concerned about the presence of "noninvasive GLUCONTROL" on the register is not for the Board to opine on. The Board should not substitute its judgment for that of opposer on a commercial concern. Cf. Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank, 842 F.2d 1270, 6 USPQ2d 1305 (Fed. Cir. 1988).

Apart from the registration evidence, applicant has also made of record eight exhibits (exhs. 31-38) and the (Ferren) testimony regarding the gathering of those exhibits, specifically, reprints of web pages and

brochures or publications that applicant's witness was able to obtain. We agree with opposer that, insofar as these exhibits and the related testimony are intended to establish use in commerce of the marks shown in these exhibits, the evidence suffers from hearsay and foundation problems. Nonetheless, we have not excluded this evidence, for we take it as probative of the fact that applicant's witness was able to find these materials on the web or via the marketplace. This, however, provides little, if any, support for applicant's argument that there is no likelihood of confusion. These exhibits show some of the same marks that are covered by the registration evidence; and we have already explained why we do not find the registered marks probative of no likelihood of confusion.

Extent of Actual Confusion

The record does not include any evidence of actual confusion, which must favor applicant. We note, however, that this factor does not weigh heavily in applicant's favor. The record focuses on less than three years of contemporaneous marketing of the involved products. Applicant's product was not introduced until two months into 1999, and 1999 sales were but a small fraction of those in 2000 and in that portion of 2001 prior to the

taking of testimony. Ferren test. exh. 2. In addition, as previously noted, the vast majority of applicant's sales are private label sales and the record reveals that some of these result in ultimate promotion of the product under the private labeller's brand name, while the GLUCOSOL mark is presented inconspicuously as an active ingredient of the product. See Ferren test. pp. 48-49 and exhs. 20 (documents D25 and D26) and 22.

More importantly, because we must, inter alia, consider the likelihood of confusion if opposer's marks are used on over-the-counter medications and even "natural" anti-diabetic preparations contemporaneously with applicant's use of its mark for supplements -- circumstances which have not yet arisen -- the absence of evidence of actual confusion is of limited probative value in deciding the question of likelihood of confusion.

Balancing of du Pont Factors

In weighing the factors, we keep in mind that consideration of the cumulative differences or similarities of the involved marks and goods are often of primary importance. See, e.g., Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). On balance, we find the marks substantially

similar in sight and sound; that they are actually used for related goods and may, because of the involved identifications, be used for even more closely related and competitive goods; that opposer's marks are strong and well-known; and that the products contemplated by the identifications can be sold in the same retail stores. For all these reasons, we find that the opposition should be sustained. Further, we note that applicant, as the newcomer, had the opportunity to select a mark that would not create a likelihood of confusion with opposer's previously-used and well-known marks, so that, if we had any doubt, we would resolve it in favor of opposer. Finally, given the significant public health issues that arise when we consider the question of confusion among consumers when products used to treat disease are involved, we are compelled to apply the likelihood of confusion analysis more strictly.

Decision: The opposition is sustained.